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IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. 893

PAYNE FURNACE AND SUPPLY COMPANY, INC., a corporation,

Petitioner,

vs.

WILLIAMS-WALLACE COMPANY, a corporation,

Respondent.

Petition for Writ of Certiorari to the Circuit Court of Appeals for the Ninth Circuit and Brief in Support Thereof.

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Petition for Writ of Certiorari to the Circuit Court of Appeals for the Ninth Circuit and Brief in Support Thereof.

To: The Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, PAYNE FURNACE AND SUPPLY COMPANY, INC., respectfully prays for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit to review a judgment of that Court entered February 14, 1941. The judgment sought to be reviewed affirms a judgment of the District Court of the United States for the Northern District of California, holding U. S. Patent No. 2,013,193 and claims 1, 2 and 3 thereof, as modified by disclaimers, valid and infringed, and granting an injunction against petitioner. The judgment of the Circuit Court of Appeals turned upon the sole question of the validity of the disclaimers. The decision of the Circuit Court of Appeals was by a divided court.

Summary of the Matter Involved.

This case presents directly the important and troublesome question of excission by disclaimer by an inventor or his assignee from a patent of "a material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer" (*R.S.U.S. 4917 and 4922 – 35 USCA, Secs. 65 and 71*).

The decision of the Circuit Court of Appeals, upon which the judgment sought to be reviewed was based, considered solely the question of validity of the disclaimers filed by the patent owner. No other question was decided by the Court of Appeals or is sought to be reviewed.

This Court, in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corporation,* 294 U.S. 477, 490, has considered this disclaimer statute, saying:– "* * * it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination."

The decisions of the district courts and of the circuit courts of appeals reveal, *first,* a confusion and conflict of interpretation of this disclaimer statute, and, *second,* that notwithstanding this Court's said decision, this confusion and conflict persists. There has grown up a mounting abuse of the privilege granted by this disclaimer statute. Patentees seek to avoid the requirements of the reissue statute *(R.S.U.S. 4916)* by assertedly,

under this disclaimer statute, filing so-called "qualifying", "discretionary", or "precautionary" disclaimers, by which the patentee attempts *ex parte* to restate and amend his patent claim and to thereby avoid submitting the restated or amended claim to revision or restriction by the customary Patent Office procedure. Decisions have been rendered approving this procedure, and holding that the filing of a disclaimer is not an admission that the claim as granted is invalid, but merely an amendment or restatement of the claim out of caution, and that that which is comprehended by the claim as granted may still be adjudged the novel and patentable invention of the patentee, —that the disclaimer may be ignored as unnecessary, because the disclaimer is not an admission that by the claim as granted the patentee has claimed "more than that of which he was the original or first inventor or discoverer," —and holding that in considering whether a disclaimer is valid within this statute the court may, in construing the claim as restated and amended by the disclaimer, disregard the established rules of interpretation applicable to the claim as granted when considering it to determine its validity or infringement, and may read into the claim any desired structural characteristics or limitations not mentioned in the claim but found in the description (specification) and drawings of the patent.

By its terms and purpose, (*Ensten v. Simon Ascher & Co.*, 282 U.S. 445,) the disclaimer statute is applicable only where the patentee has claimed more than that of which he was the original or first inventor or discoverer.

The facts in the present case, while simple and appearing on the face of the patent and the purported disclaimers, are such as to present most of the phases of this problem with which the lower courts have struggled.–

(1) By disclaiming a part of the thing patented on the basis that the patentee was not the original and first inventor or discoverer thereof, (a) is the patentee thereafter precluded or estopped from asserting such part was his original invention or discovery, and (b) in interpreting the patent as modified by such disclaimer, must the court consider the disclaimed part as not the invention of the patentee, but a part of the prior public knowledge and in the public domain?

(2) Is the rule of interpretation different, when the court is called upon to interpret a patent claim to determine whether a disclaimer is invalid as adding a new element thereto, from the rule of interpretation where such patent claim as granted is before the court to determine its validity or infringement?

(3) In considering whether a disclaimer is valid, to what extent (if at all) does the explanatory or interpretative effect of the drawings and description (specification) of the patent empower the court to read into the patent claim, as granted, structural characteristics or limitations which are described in such drawings and description, but are not directly or indirectly pointed out or referred to in the claim as granted?

(4) When a court is called upon to determine whether a disclaimer is valid as falling within the class "by limiting the claim to a specific type of the general class to which it was applied", to what extent (if at all) does the explanatory or interpretative effect of the drawings and the specification of the patent empower the court to read into the patent claim as granted (1) a general class and (2) a structural antecedent for the purpose of creating a foundation for limiting the claim by the disclaimer to structural characteristics of such general class and interpolated structural antecedent?

(5) By disclaimer may a patentee add, to a granted patent claim for a combination of mechanical elements, another combination of mechanical elements described in the patent and shown in the drawings thereof, for which second combination of elements he originally sought a claim in his application for the patent, which original claim was rejected and adjudged lacking in novelty and cancelled?

(6) Can a court hold that a disclaimer narrowing claims to structural characteristics is valid when the effect is to obtain a new and different combination from that of the patented claims?

The majority opinion herein illuminates the necessity of a further decision by this Court further clarifying and establishing the law applicable to these questions.

Statement of the Matter Involved.

Patent 2,013,913 [R. Vol. III. p. 636] was granted for Composite Pipe Construction. The patent contained three claims. Respondent as owner thereof filed disclaimers to each of the claims [R. 638]. The District Court adjudged the patent claims valid as modified by the disclaimers [R. 51, 62] and granted an injunction [R. 65]. On appeal the Circuit Court of Appeals in a majority opinion (by Circuit Judges Denman and Healy, Circuit Judge Mathews dissenting) affirmed the grant of said injunction [R. Vol. IV. 922-36]. The disclaimers are quoted in the majority opinion at R. 928-29.

The alleged invention as comprehended by the three patent claims as granted was a composite pipe consisting of two pipes, one within the other, with insulating material (asbestos) there-between, the inner pipe being slidable within the outer pipe.

The qualifying disclaimers disclaimed "any combination of the recited elements" of the patent claim with certain stated exceptions. For example, the patent describes and illustrates in the drawings the formation of leak-proof joints, between sections of the composite pipe, by crimping the ends of the pipes and inserting the upper end of an outer pipe within the lower end of the inner pipe so that condensate moisture running down the outside of the composite pipe cannot enter the joint; similarly forming a leak-proof joint by inserting the lower end of the inner pipe within the upper end of the inner pipe so that condensate moisture running down the inside of the inner pipe cannot pass through the leak-proof joint thus formed.

The original application for the patent contained claims for this leak-proof joint construction. Said claims were rejected upon prior patents and cancelled [R. 697, 701, and 698, 709]. The patent claims as granted do not disclose that the invention resides in any manner in the formation of sectional pipe or the connection of the sections together. The majority opinion of the court below holds that the disclaimers do not alter the original combination of a single unit pipe into one having a plurality of sections; that such a construction would require the court "to close our eyes entirely to the drawings and specifications of the patent", and the majority opinion interprets, therefore, the original claims as addressed to a plurality of sections [R. 933.] The disclaimer limiting the composite pipe to a sectional construction was incidental only to the inclusion of other elements. Respecting that portion of the disclaimers which incorporated into the patent claims these other elements, (*i. e.*, the formation of leak-proof joints between adjoining sections of the pipes,) the majority opinion declares this to have been a part of the patent claims because they are structural characteristics described in the specification. The majority opinion does not attempt to assert that there is any antecedent in either of the patent claims which can refer to such leak-proof joint formations. Said majority opinion states:—

> "After the disclaimer, as before, the combination consists of three elements, plus the functional feature of slidability. These elements, however, as modified

by the disclaimer, have certain structural characteristics or limitations not mentioned in the claims. Each metal pipe has one crimped end in a designated alignment, and the insulation has 'a plurality of air cells running longitudinally therethrough.' The rest of the disclaimer, we think, is confined to matters of function. Do these limitations operate to import new elements so as to transform the original combination into a new and different one, as for example in the case of the flywheel in the combination involved in the Altoona Theatres decision, *supra*?

"The answer to the question is neither obvious nor easy, but we think it should be in the negative. The flywheel was a new part or mechanism. The limitations here are structural or functional. We are unable to read the disclaimer as attempting to do more than confine the claims to the specific environment already fixed in the specifications and drawings. By it the inventor undertakes to narrow the field of the claimed monopoly by introducing structural limitations taken directly from the specifications. This has been held proper in analogous situations." [R. 934.]

The majority opinion is based upon a confusion of the legal meaning of footnote (3) to p. 490 of 294 U.S. (this Court's opinion in the *Altoona Theatres* case). In this footnote it is stated that there are four classes of disclaimers, the fourth or last class being disclaimers *"by limiting the claim to a specific type of the general class to which it was applied."* The footnote cites three deci-

sions, none of which clarifies this portion of the text. The distinction between the disclaimers in the said decisions so cited, and the interpretation of the class of disclaimer given thereto by the Circuit Court of Appeals herein illustrates the necessity for clarification by decision of this Court.

Other decisions cited by the Court of Appeals [R. 932] are based upon the hypothesis that because a disclaimer is voluntary it may be adjudged to have been unnecessary and the issues of invention and patentable novelty adjudged on the basis that no disclaimer was necessary and that the patentee was the original and first inventor of the combination disclosed by the patent claim (without disclaimer) notwithstanding the admission by the disclaimer that such claim comprehended more than he invented. In this class are the decisions by the Circuit Court of Appeals for the Sixth Circuit in *Metropolitan Device Corporation v. Cleveland E. Illuminating Co.,* 36 F. 2nd 477, 478, 479; *Permutit v. Wadham,* 13 F. 2nd 454, 457; and *N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co.,* 29 F. 2nd 968, 969 (same case, 56 F. 2nd 512, 513), specifically holding: "The disclaimer was not a confession of anticipation in the absence of disclaimer."; and the decision of the Circuit Court of Appeals for the Second Circuit in *Sachs v. Hartford Electric Supply Co.,* 47 F. 2nd 743, 746, 747.

There is therefore a confusion in the decisions of the lower courts as to the effect of the disclaimer statutes and

of the patentee's filing a disclaimer,—presenting this question:– Can a patentee disclaim a patent claim, modify such claim by the inclusion of additional limitations, and thereafter be heard to assert and have the court adjudge that the disclaimer was unnecessary; that the patentee was the original and first inventor of the subject matter thereof (so disclaimed), and that the claim as modified by the disclaimer is valid because the patentee was the first inventor of that which he disclaimed? That this question has confused the Court of Appeals in the instant case is apparent from the following statement [R. 935] from the majority opinion:–

> "The patentee appears to have been moved by the desire to disclaim any monopoly in his composite pipe save when used for the purpose and assembled in the precise manner fully described in his specifications. We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed."

In his dissenting opinion, Circuit Judge Mathews held that:–

> "The so-called disclaimer is such in name only. Instead of disclaiming the whole or a part of one or more of the three combinations claimed in the patent, it describes and claims three new combinations. This the law does not permit." [R. 936.]

Reasons Relied Upon for Allowance of Writ.

The lower court decisions clearly disclose a conflict respecting:–

(1) The rule of interpretation of a patent claim. A different rule is applied, in construing the claim to ascertain what is embraced thereby when the patentable novelty is to be adjudged, from the rule that is applied when the subject-matter of the claim is to be determined to ascertain whether a disclaimer adds a new element thereto, under the *Altoona Theatres* decision.

(2) Whether a disclaimer is an admission that the patent claim as stated in the patent is invalid, or whether the disclaimer may be adjudged unnecessary and the patentee "at liberty, after the disclaimer as before, to deny the anticipatory effect of the other matter;" (*Permutit v. Wadham,* 13 F. 2nd 454, 457).

(3) The patentee having by disclaimer asserted that the claim as granted contains more than that of which the patentee was the original or first inventor, whether in an infringement suit after such disclaimer the court can adjudge the disclaimer unnecessary and, disregarding the disclaimer, independently examine the question of patentable novelty as presented by the record evidence, and find patentable novelty in the granted claim (not dependent upon the excission or restriction of the disclaimer)?

(4) Whether a disclaimer can validly incorporate into a patent claim as the patentable novelty anything not disclosed by such disclaimed claim; to what extent (if at all) can recourse be had to the description and drawings to read into the patent claims structural or functional limitations, described in the patent specification or shown

in the drawings, which are not disclosed and for which no antecedent exists in the patent claim?

(5) To what facts and circumstances does that class of disclaimers refer which is comprehended in said footnote ([8]) to p. 490 of 294 U.S. (the *Altoona Theatres* decision), to wit: "by limiting the claim to a specific type of the general class to which it was applied."

The majority opinion of the Circuit Court of Appeals herein definitely shows that said court has decided important questions of federal law which have not been, but should be settled by this Court, and has decided other questions of federal law in conflict with applicable decisions of this Court (Rule 38, Par. 5, Subd. (b)).

Jurisdiction.

Under Section 240(a) of the Judicial Code as amended by the act of February 13, 1925 (28 USCA, 347(a)), this Court has jurisdiction to review the judgment of the Court of Appeals herein. Judicial Code Sec. 41(7) gives the District Courts of the United States original jurisdiction "of all suits at law or in equity arising under the patent, the copyright, and the trade-mark laws". The instant case is a suit in equity to enjoin infringement of U.S. Patent 2,013,193. The Circuit Court of Appeals had jurisdiction of Petitioner's appeal (Jud. Code. Sec. 129) from the grant by the District Court of an injunction.

The judgment of the Circuit Court of Appeals was entered February 14, 1941, and this petition is filed within three months thereafter (28 USCA 350; R.S. Sec. 1008 as amended, Sec. 6 act of Sept. 6, 1916, 39 Stat. 727).

In conformity with the provisions of Rule 38 of this Court, a certified copy of the record, including the proceedings in and the opinions of the Circuit Court of Appeals in this case, accompanies this petition.

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Ninth Circuit, commanding that court to certify and send to this Court on a day to be designated a full and complete transcript of the record and all proceedings of said Circuit Court of Appeals had on this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of said Circuit Court of Appeals be reversed, and that your petitioner may be granted such other and further relief as may seem just and proper.

Respectfully submitted,

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No. .....

PAYNE FURNACE AND SUPPLY COMPANY, INC., a corporation,

Petitioner,

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WILLIAMS-WALLACE COMPANY, a corporation,

Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I. Opinion of the Court Below.–

The majority opinion of the Court of Appeals is found in Vol. IV. at p. 922. The dissenting opinion of Circuit Judge Mathews is at p. 936. The findings of fact and conclusions of law entered by the District Court are at R. pp. 49-62. The District Court did not write an opinion [R. 48-49].

II. Jurisdiction.–

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the act of February 13, 1925; 28 USCA, Sec. 347(a). The date of the judgment to be reviewed is February 14, 1941 [R. 937].

III. The Disclaimer Statute.–

R.S.U.S. Secs. 4917 and 4922 "are parts of one law having one general purpose, and that purpose is to obviate the inconvenience and hardship of the common law, which made a patent wholly void if any part of the invention was wrongfully claimed by the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it." (*Ensten v. Simon Ascher & Co.*, 282 U.S. 445, 452.) "The statute is remedial; the intent is to aid the inventor free from wilful default or intention to mislead the public by permitting him to avoid the consequence of inadvertence, accident or mistake through prompt disavowal of the apparent right to exclude others from something improperly included in the words of his grant." (*Idem*, p. 452.)

The disclaimer statute "expressly limits a disclaimer to a rejection of something before claimed as new" (*Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 112 U.S. 624).

IV. Is the Patentee After Filing Disclaimer Precluded or Estopped From Asserting That the Disclaimed Part Was His Original Invention or Discovery?–

The Court of Appeals for the Sixth Circuit, in *Permutit Co. v. Wadham*, 13 F. 2nd 454, 457, held:–

> "We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. The patentee decides a question of policy; he may think that, although the supposed anticipation can be successfully met and defeated, a disclaimer will not af-

> fect the real value of his patent, and to make it will save trouble and expense and do no harm. We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect of the other matter; and it has been so held. Manhattan Co. v. Helios Co., 135 F. 785, 802."

and in *Metropolitan Device Corporation v. Cleveland E. Illuminating Co.*, 36 F. 2nd 477, 479, said:–

> "The view we take is that the matter of disclaimer was within the discretion of the patentee to be reasonably exercised—'a matter of policy'—(Permutit Co. v. Wadham, 13 F. (2d) 454, 457 (C.C.A. 6)) * * *."
>
> *Cf. N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co.*, 29 F. 2nd 968, 969 (C.C.A. 6).

The Court of Appeals for the Second Circuit, in *Sachs v. Hartford Electric Supply Co.*, 47 F. 2nd 743, 747, said:–

> "However, we do not see that these limitations were in any sense necessary to escape the prior art. A disclaimer is to abandon some part of the invention of which the patentee is not 'the first and original inventor.' If he has claimed originally too much, so that the claims are invalid under the prior art, the part disclaimed must be clearly separate in the body of the specifications; if he wishes to recast the whole, he must go to a reissue. But there is no objection to his limiting a valid patent as his fears may dictate; that does not make valid what would be invalid without it. It is a timorous retreat from positions which he could have successfully maintained. We can there-

fore disregard all of the disclaimer except so much as was necessary to limit claim fourteen, and so much was valid."

The Court of Appeals herein says [R. 935]:–

"The patentee appears to have been moved by the desire to disclaim any monopoly in his composite pipe save when used for the purpose and assembled in the precise manner fully described in his specifications. We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed."

Are not these decisions of the Courts of Appeals for the Sixth, Second, and Ninth Circuits in conflict with the *Altoona Theatres* decision, wherein this Court said (294 U.S. 492):–

"With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim, or hold by virtue of the patent.' Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public.

"While the precise effect of an invalid disclaimer upon the original claim seems not to have been judicially determined, analogous principles of the

patent law are so well recognized as to leave no doubt what our decision should be. It has long been settled that a claim abandoned or rejected in the patent office with the acquiescence of the applicant cannot be revived in a re-issued patent. Yale Lock Mfg. Co. v. Berkshire Nat. Bank, 135 U.S. 342, 379, 34 L. ed. 168, 183, 10 S. Ct. 884; Dobson v. Lees, 137 U.S. 258, 263-265, 34 L. ed. 652, 654, 655, 11 S. Ct. 71."

The Court of Appeals herein said:–

"We do not understand that the Supreme Court in the Altoona Theatres decision, supra, intended to overrule the many decisions upholding disclaimers of this character." [R. 933.]

If the decision herein upon this question is not contrary to said *Altoona Theatres* decision, then there is a necessity for a further review and an additional decision by this Court. The disclaimer statute does not authorize a patentee to disclaim a material or substantial part of the thing patented, upon his acknowledgment that through inadvertence, accident, or mistake, and without fraudulent or deceptive intention he has claimed more than that of which he was the original or first inventor or discoverer, and to then assert,—against such deliberate act in disclaiming,—that of such disclaimed part he was the original or first inventor or discoverer.

If the Court of Appeals herein has decided this question contrary to this Court's decision in the *Altoona Theatres* case certiorari should be granted under *Rule 38* of this Court, *Par. 5, Subd. (b)*, as a decision of a question of federal law in conflict with the applicable decision of this Court.

That the Court of Appeals herein has relied upon the *Permutit v. Wadham, Metropolitan Device Corp. v. Cleveland E. I. Co., N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co.,* and *Sachs v. Hartford Elec. Supply Co.* decisions, is demonstrated by the statements in the majority opinion:– "A disclaimer is not necessarily an admission that the patent would be void in the absence of the disclaimer." (Citing these cases.) "Inventors, it would appear, sometimes resort to the disclaimer statute as a matter of policy or precaution in the hope that they may thus forestall litigation, often with the result that more trouble is stirred up than avoided. Or they may be moved to disclaim because on reflection they fear that the claims are so broadly stated as to include a range of equivalents wider than the spirit of the invention justifies." [R. 931-32.] "We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed." [R. 935.]

The majority opinion herein finds the disclaimer unnecessary, and finds novel patentable invention in the combination of elements disclosed *in the patent claims as granted,* saying [R. 925]:–

> "The invention disclosed, if invention there be, resides in the combination of known elements—namely, in a composite pipe section comprising an inner core pipe, an external pipe, and insulating material interposed between the two, plus the functional relationship of slidability of the inner pipe providing a construction in which, necessarily, the inner and outer stacks are supported independently of each other when the unit sections are joined together."

A careful reading of such opinion shows that the court does not adjudge any of the so-called restrictions of the disclaimers as importing any patentable novelty into the claims; nor are any of such disclaimers given any effect in adjudging the novelty of the claimed combination.

The male and female fittings forming leak-proof joints were claimed in rejected application claims 3, 4, 5 and 8 [R. 936]. The Court of Appeals herein does not find any patentable novelty therein [R. 925-926]. So far as the leak-proof joints are concerned, the disclaimers simply combine with the combination of the patent claims as granted the old rejected combination claims, 3, 4, 5 and 8 upon the leak-proof joints, and the decision herein is predicated upon a finding of patentable novelty in the patent claims as granted, disregarding the inclusion of such old leak-proof joint combination as immaterial.

V. In Interpreting a Patent Claim as Modified by a Disclaimer, Must the Court Consider the Disclaimed Part as Not the Invention of the Patentee, But a Part of the Prior Knowledge and in the Public Domain?–

The disclaimer statute is predicated upon a patentee claiming in his patent more than that of which he was the original or first inventor or discoverer. If he elects to avail himself of the provisions of this statute, his action in disclaiming "a material or substantial part of the thing patented" must be for the reason that "he was not the original or first inventor or discoverer" of such material or substantial part of the thing so patented. We have been unable to find in any of the decisions of this Court a direct statement supporting or repudiating this proposition, or that the disclaimer statute can apply only to such

an excision. Nevertheless, the lack of such an authoritative determination has caused much of the confusion existent in the lower court decisions attempting to construe and apply this disclaimer statute, and further decision by this Court, so determining and interpreting this disclaimer statute, is highly important and presents an important question of federal law.

VI. The Patent Claims as Granted, and the Modifications and Interpolations Made Therein by the Disclaimers.–

Each of the three patent claims is for a combination of mechanical elements [*R.S.U.S. 4888*].

The distinction between the claims as granted in the patent and the restatement thereof by the disclaimer is made clear by the following comparison:

The Patent Claims.	*The "Disclaimer" Claims.*
CLAIM 1.	CLAIM 1.
A composite pipe construction	Composite sectional pipe for conducting fluids or gases of combustion
comprising	comprising
(a) an outer tube,	(a) an outer tube,
(b) one or more layers of insulating material located around the inside surface of the said tube, and	(b) one or more layers of insulating material located around the inside surface of the said tube,
(c) an inner tube slidably located inside the insulating material.	(c) an inner tube slidably located inside the insulating material,

The Patent Claims.

CLAIM 1.

The "Disclaimer" Claims.

CLAIM 1.

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

The Patent Claims.

CLAIM 1.

The "Disclaimer" Claims.

CLAIM 1.

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler and has a plurality of air cells running longitudinally therethrough.

CLAIM 2.

A composite pipe construction

comprising

(a) an outer tube,

(b) a layer of insulating material formed into a tube and positioned inside the outer tube with its outside surface in contact with the inner surface of the outer tube, and

(c) an inner tube slidably positioned inside the tube of insulating material with its outer surface in contact with the inner surface of the said tube of insulating material.

CLAIM 2.

Composite sectional pipes for conducting fluids or gases of combustion

comprising

(a) an outer tube,

(b) a layer of insulating material formed into a tube and positioned inside the outer tube with its outside surface in contact with the inner surface of the outer tube,

(c) an inner tube slidably positioned inside the tube of insulating material with its outer surface in contact with the inner surface of the said tube of insulating material,

The Patent Claims.

CLAIM 2.

The "Disclaimer" Claims.

CLAIM 2.

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

The Patent Claims.

CLAIM 2.

The "Disclaimer" Claims.

CLAIM 2.

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler and has a plurality of air cells running longitudinally therethrough.

CLAIM 3.

A compcsite pipe construction

comprising

(a) an inner core pipe,

(b) an external pipe spaced from the inner pipe, and

(c) insulating material interposed between the two pipes, the said pipes being telescopically arranged with respect to one another.

CLAIM 3.

Composite sectional pipes for conducting fluids or gases of combustion,

comprising

(a) an inner core pipe,

(b) an external pipe spaced from the inner pipe,

(c) insulating material interposed between the two pipes, the said pipes being telescopically arranged with respect to one another,

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female

The Patent Claims.
CLAIM 3.

The "Disclaimer" Claims.
CLAIM 3.

end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler.

The foregoing comparison of the patent claims as granted and the purported disclaimer's re-statement and re-construction of claims makes clear:–

The Patent Claims.—These clearly define as the invention patented a single length of composite pipe construction comprising three elements only,– (a), (b) and (c). They do not in any manner indicate,—much less "particularly point out and distinctly claim,"—that the invention resides in providing sectional composite pipes, nor that the invention includes mechanical means,—much less a specific form and interrelation of mechanical means,—for joining the lengths of pipe or sections together, or that such joining or connecting means are of such form or construction as to provide leak proof joints between the adjoining sections. The majority opinion herein points this out:– "It will be seen that the claims do not advert to the matter of male and female fittings so as to provide leak-proof joints" [R. 924]. There is absolutely nothing in the patent claims which even hints at, much less "particularly point(s) out and distinctly claim(s)", that the patented invention is in any degree whatsoever dependent upon (1) the formation of a leak proof joint between sections of pipe, or (2) that such leak proof joint is made by the provision of male and female fittings, or (3) that the completed joint between adjacent ends of adjoining sections of the inner and outer pipes is in substantial radial alignment, or (4) that by the leak proof joints, so formed by male and female fittings, etc., each string of connected pipe is independently supported or maintained in connected relationship.

The Disclaimer Claims.—These attempt to define another and different and unpatented invention as existing in a combination, the first element of which is sectional

pieces of the composites pipe defined in the patent claims, *and* the second element of which is (d) a particular means for joining the sections together in such manner to, and for the purpose of, producing joints between the sections, which joints (e) shed exterior moisture and are leak proof, *and* in which the completed joints between adjacent ends of adjoining sections are in substantial radial alignment; *also* (f) that thereby each string of connected pipe is independently supported and maintained in connected relationship, and further and independent of the thus claimed combination between the sections and the connecting means, these disclaimer claims specify a particular attribute of a particular form of insulating material not a part of the patent claims, i. e., (g) that the insulating material between the two pipes of the sections shall provide an intermediate filler having a plurality of air cells running longitudinally therethrough.

For the sake of emphasis, as well as clarity, we repeat that the disclaimer claims would embrace the following, *not called for or comprehended by the patent claims*:—

(1) that the composite pipe should be made in a plurality of sections;

(2) that adjacent ends of the inner and outer pipes of each section shall have a particular mechanical element for connecting sections together, to wit: male and female ends, etc.;

(3) that these connecting means shall be such that

(a) a joint is provided between the sections which sheds any exterior moisture, and

(b) that the completed joints are in substantial radial alignment;

(4) that the respective outer and inner tubes of the connected sections shall be independently supported and maintained in connected relationship;

(5) that the insulating material interposed between the two pipes shall be of such form and construction as to provide an intermediate filler having a plurality of air cells running longitudinally therethrough.

The majority opinion of the Court of Appeals states:– "It will be seen that *the claims do not advert to the matter of male and female fittings so as to provide leak-proof joints*" [R. 924]. Each of the patent claims is totally silent as to whether the claimed composite pipe is even jointed. The majority opinion of the Court of Appeals herein points out that there is no antecedent for the male and female fittings to provide leak-proof joints, but relies upon structural characteristics which it finds "implicit in the spirit of the invention claimed" [R. 935], justifying its interpolation into the patent claims as granted of said leak-proof joint structures under a confused and erroneous application of the fourth class of disclaimers referred to in footnote (3) of p. 490 of the *Altoona Theatres* decision in 294 U.S., to wit: *"by limiting the claim to a specific type of the general class to which it was applied"* [R. 933].

The majority opinion herein cites the decision in *Byrne Mfg. Co. v. American Flange Co.*, 87 F. 2nd 783 (C.C.A. 6) as "on all fours with the present case" [R. 934]. Do not the facts of such case bring it within the rule of valid disclaimer "by limiting the claim to a specific type of the general class to which it was applied"? In this *Byrne* case, claim 1 called for a "flange" and for a "support" (see footnote, p. 784 of 87 F. 2nd). Was not the effect

of the disclaimer to limit claim 1 to a particular type of "flange" and to a particular type or construction of "support", both limitations corresponding to the types of "flange" and "support" shown and described in the specification? The decision herein, and the reliance placed upon this *Byrne* decison, exemplifies the necessity for a further decision clarifying what is comprehended by the class of disclaimers referred to. The patent claims herein neither directly nor indirectly refer to any joints. How can the disclaimers herein, therefore, be adjudged to limit the claims to a specific type of the general class of joints, when no joints are called for by the granted claims? This fact is recognized by the majority opinion of the Court of Appeals [R. 934]. Said opinion, however, reads this element into the patent claims as granted by an explanatory or interpretative office of the drawings and specifications, upon which the opinion relies as "not to be ignored" [R. 933]. The rule of interpretation that an element or feature of construction cannot be interpolated into a claim for either the purpose of making out a case of novelty or of infringement was early established in *McCarty v. Lehigh Valley Railroad,* 160 U.S. 110. It is repeated in the *Altoona Publix Theatres* case:–

> "While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination." (294 U.S. p. 490.)

In determining whether a disclaimer is valid, does this rule apply in interpreting the patent claims as granted; or may the court "narrow the field of the claimed monopoly by introducing structural limitations taken directly from the specifications" [R. 934] into the granted patent claims as an antecedent for the disclaimer?

VII. There Is Confusion and Uncertainty as to What Is Comprehended by the Fourth Class of Disclaimers of Footnote ([3]), p. 490 of the Altoona Theatres Decision (294 U.S.), To Wit: "By Limiting the Claim to a Specific Type of the General Class to Which it Was Applied."

Said footnote refers to three decisions. The first is *Minerals Separation v. Butte & S. Min. Co.,* 250 U.S. 336, 354. In this case the disclaimer was not to a specific type of a general class of ingredients. The disclaimer therein was not of any type of oils.– "From this consideration of the terms of the patent as written, it is apparent that it makes no differentiation whatever, either in the claims or in the specification, among the oils having a preferential affinity for metalliferous matter, * * *." (250 U.S. at 348.) The disclaimer disclaimed from claims 9, 10 and 11 of the patent, "any process of concentrating powdered ores, excepting where the results obtained are the results obtained *by the use of oil in a quantity amounting to a fraction of 1 per cent. on the ore.*" (*Cf.* 250 F., bot. p. 249.) (Emphasis supplied.)

The second case referred to in said footnote is *United Chromium v. International Silver Co.,* 60 F. 2nd 913 (C.C.A. 2). The original patent claims called for a process in which the proportion of certain ingredients was established at the start of the process. By disclaimer,

language was added which merely required that afterwards in the operation of the process the operator continued to maintain the same proportions that the claims had originally stated must be established at the start of the process. This did not present any question of disclaimer of a specific type or of the general class of materials to which the patent claims applied.

The third case referred to in said footnote is *Sieberling v. John E. Thropp's Sons Co.,* 284 F. 746 (C.C.A. 3), in which the Court of Appeals divided respecting whether: "The elements remaining after the disclaimer was filed are not only a new combination, but they are invested with a distinct method of operation not claimed in the old combination." (dissenting opinion of Circuit Judge Davis, 284 F. at p. 759). The disclaimer and the patent claim are set forth at p. 757 of 284 F. The patent claim called for "a power-driven ring core" and "a spinning roll * * * to shape the sheeted fabric on the core * * *." The disclaimer disclaimed any –

> "combination of the recited elements *except when* constructed and co-ordinated for shaping and applying a previously unshaped sheet fabric strip to that part of the recited ring core beyond the tread portion, *and unless* the power drive for the ring core functions by a sufficiently high speed of rotation and consequent centrifugal force to throw the unapplied fabric portion out from the side of the ring core, while the recited spinning roll in its radial movement, and while pressed toward the ring core, functions by a gradual action upon such centrifugally thrown-out fabric to shape it to the side of the rotating ring core while bringing it into adhesive contact therewith."

This Court granted certiorari. When the case came before this Court, the question of disclaimer was not considered because:– "As we have found that there is nothing really new in the method or mechanism of State, it will serve no purpose to go through the qualifying disclaimers in detail and consider their effect." (264 U.S. 330).

The confusion and uncertainty presented by this footnote (3) to the *Altoona Theatres* case decision have caused such a confusion in the minds of the majority of the Court of Appeals herein that the rule of such footnote requires further clarification by this Court. The impossibility of applying the kind or character of disclaimer of any of the three cited decisions to the facts of this case is apparent. The misconception by the Court of Appeals herein of that class of disclaimers referred to, and its inapplicability to the facts of this case, have caused the Court of Appeals herein to decide this case contrary to the *Altoona Theatres* decision and the decisions in the cases cited in said footnote (3).

CONCLUSION.

We respectfully submit, for the reasons stated in the petition, the prayed for relief should be granted and this Court should settle and clarify by another decision these confusing questions applicable to the disclaimer statute.

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(2)

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In the Supreme Court of the United States

October Term, 1940

No. 893

PAYNE FURNACE & SUPPLY CO., INC., a corporation,

Petitioner,

vs.

WILLIAMS-WALLACE COMPANY, a corporation.

On Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit

Brief for Respondent in Opposition to Petition for a Writ of Certiorari

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In the Supreme Court of the United States

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PAYNE FURNACE & SUPPLY CO., INC., a corporation,

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WILLIAMS-WALLACE COMPANY, a corporation.

On Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit

Brief for Respondent in Opposition to Petition for a Writ of Certiorari

OPINIONS BELOW

No opinion was delivered by the District Court; its findings of fact and conclusions of law (R. Vol. I, 49-62) are unreported. The opinion of the Circuit Court of Appeals (R. Vol. IV, 922) is reported at 117 F. (2d) 823.

JURISDICTION

The judgment of the Circuit Court of Appeals was entered on February 14, 1941 (R. Vol. IV, 937). The petition

for a writ of certiorari was filed on March 27, 1941. The jurisdiction of this Court is invoked under section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925.

STATEMENT OF THE CASE

This suit was brought by respondent in the District Court of the United States for the Northern District of California to enjoin, and to recover damages for, the infringement by petitioner of Letters Patent No. 2,013,193, covering an invention relating to composite flue pipe construction (R. Vol. I, 1-6). Petitioner conceded that its device is an infringement if the patent is valid (R. Vol. I, 82; Vol. IV, 922, 926). The District Court held the patent valid and infringed and ordered the cause referred to a Master for an accounting (R. Vol. I, 63).

On appeal petitioner repeated its contentions made in the District Court that the patent is invalid (a) for anticipation, and (b) because a disclaimer which was filed by respondent at the opening of the trial is defective. The Circuit Court of Appeals rejected both contentions and affirmed the decree of the District Court (R. Vol. IV, 937). Judge Mathews dissented (R. Vol. IV, 936).

With respect to anticipation, the Circuit Court of Appeals, after reviewing the prior art, held that the invention was novel; that it had overcome important difficulties in the field of flue pipe art and had received immediate and wide commercial adoption in the industry (R. Vol. IV, 926-928). Among other things, the Court pointed out that when petitioner manufactured and put on the market

an exact copy of respondent's device its advertising matter proclaimed as novel the features relied on by respondent as disclosing invention (R. Vol. IV, 926). With respect to the disclaimer, the Court held that it was a valid disclaimer which confined the original claims to the specific environment already fixed in the specifications and drawings, and which did not add any new element to the combination claimed in the original patent (R. Vol. IV, 928-936).

ARGUMENT

The Petition for Certiorari Should Be Denied. It Seeks Review Merely of Questions of Fact and the Construction of the Particular Patent Involved in This Suit. It Exhibits No Conflict of Decisions and No Such Conflict Exists.

Petitioner has abandoned its contention that the patent is invalid for anticipation. In the "Reasons Relied Upon for Allowance of Writ" (Pet., 11-12), and elsewhere in the petition and brief (pp. 4-5, 10, 16, 21, 32), petitioner states a large number of hypothetical questions of patent law, and asserts that these are questions which have not been settled by this Court and as to which "confusion" exists in the lower federal courts. Most of these questions are not involved in this case and are, therefore, purely academic.[1] With respect to this case, petitioner's only

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1. In passing we point out, however, that all of the hypothetical questions stated are answered by the following decisions of this Court:

Dunbar v. Myers (1876), 94 U. S. 187, 193, 194;
Minerals Separations v. Butte etc. Min'g Co. (1919), 250 U. S. 336, 354;

contentions are that the decision of the Circuit Court of Appeals is erroneous in that (a) the Court, in construing the claims of the patent, disregarded the disclaimer, filed by respondent, and (b) the Court, in construing the disclaimer, held that it did not add new elements to the original claims.

(a) The Circuit Court of Appeals did not disregard the disclaimer. On the contrary, the Court, in construing the patent claims, expressly gave the disclaimer full effect (R. Vol. IV, 933-935). Petitioner's argument is based upon a misconception of the meaning of the following language in the opinion (R. Vol. IV, 934, 935):

> "We are unable to read the disclaimer as attempting to do more than confine the claims to the specific environment already fixed in the specifications and drawings. By it the inventor undertakes to narrow the field of the claimed monopoly by introducing structural limitations taken directly from the specifications. * * *
>
> "Perhaps the general language of Stadtfeld's claims might have been thought so broad as to cover devices other than the one particularly described in the specifications, and this possibility suggests the reason for the disclaimer. The patentee appears to have been moved by the desire to disclaim any monop-

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Hailes v. Albany Stove Co. (1887), 123 U. S. 582, 586, 587;
Altoona Theatres v. American Tri-Ergon Corp. (1935), 294 U. S. 477, 490;
Smith v. Snow (1935), 294 U. S. 1, 13, 14;
Schriber Co. v. Cleveland Trust Co. (1940), 311 U. S. 211, 217;
Westinghouse v. Boyden Power Brake Co. (1898), 170 U. S. 537, 557, 560;
Westinghouse Co. v. Formica Co. (1924), 266 U. S. 342, 354.

oly in his composite pipe save when used for the purpose and assembled in the precise manner fully described in his specifications. We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed. But no one has been prejudiced by the disclaimer. An innocuous gesture of this sort ought not compel the penalizing of the inventor by striking down a meritorious invention. That course, we think, would pervert the benign purpose of the statute, converting it from a shield in the hands of the inventor to a sword in the possession of his adversary."

This ruling is in accord with numerous authorities.[2] The petition cites, and we know of, no decision to the contrary. There is, obviously, nothing in this language or any other language in the opinion which affords any basis for a contention that the Circuit Court of Appeals failed to give full effect to the disclaimer.

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2. Among these are:
Minerals Separations v. Butte etc. Min'g Co. (1919), 250 U. S. 336, 354;
Carnegie Steel Co. v. Cambria Iron Co. (1902), 185 U. S. 403, 436;
Smith v. Snow (1935), 294 U. S. 1, 13, 14;
Schriber Co. v. Cleveland Trust Co. (1940), 311 U. S. 211, 217;
Sessions v. Romadka (1892), 145 U. S. 29, 40;
Byrne Mfg. Co. v. American Flange & Mfg. Co. (6th C. C. A., 1937), 87 F. (2d) 783, 784 (Cert. denied 302 U. S. 699);
Metropolitan Device Corp. v. Cleveland E. Illuminating Co. (6th C. C. A., 1929), 36 F. (2d) 477;
N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co. (6th C. C. A., 1932), 56 F. (2d) 512, 513 (Cert. denied 287 U. S. 617);
Sachs v. Hartford Electric Supply Co. (2d C. C. A., 1931), 47 F. (2d) 743, 746, 747 (Cert. denied 283 U. S. 854).
See the many other authorities cited by the lower court (R. Vol. IV, 932).

(b) The question whether the disclaimer adds any elements to the original patent claims involves simply the application of settled principles of law to the particular patent here in suit.[3] This is demonstrated by petitioner's own argument at pages 22-32 of its brief, which substantially repeats its argument in the court below. The ruling by the District Court (R. Vol. I, 51), affirmed by the Circuit Court of Appeals, that the disclaimer added no new elements, is, we submit, clearly correct (see R. Vol. IV, 931-935). In any event, it turns upon the construction of the claims of this particular patent, as to which there is no conflict of decisions. The question, therefore, is not one which warrants the granting of a writ of certiorari.

Keller v. Adams-Campbell Co. (1924), 264 U. S. 314, 319.

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3. Petitioner says that the last three cases cited by this Court in footnote 3 of its opinion in *Altoona Theatres v. American Tri-Ergon Corp.* (1935), 294 U. S. 477, 490, do not support the text to which the cases are cited, and that this has created "confusion and uncertainty" as to what was decided in that case (Pet. 8-9, 12, 32). Contrary to petitioner's assertion, all three of these cases support the text to which they are cited. In *Minerals Separations v. Butte etc. Min'g Co.* (1919) 250 U. S. 336, the disclaimer changed the claim from one calling *generally* for "a small quantity of oil" to one for a *specific* quantity of oil "amounting to a fraction of 1 per cent on the ore." In *United Chromium, Inc. v. International Silver Co.* (2d C. C. A., 1932), 60 F. (2d) 913, the disclaimer qualified the claim so that instead of being *general* as to the proportions of certain ingredients, it was made *specific* as to these proportions throughout the process. In *Seiberling v. John E. Thropp's Sons Co.* (3d C. C. A., 1922), 284 Fed. 746, the disclaimer qualified the claim for a tire-making machine so that instead of being *general* as to where the fabric was applied and the speed at which it ran, it was made *specific* to apply the fabric only to the tread portion and the speed was specified as enough to throw the balance of the fabric outwardly until the spinning roll gradually forced it in against the side of the tire.

These decisions involved the same type of disclaimer as that involved in the present case and also in the many cases reviewed in the decision of the Circuit Court of Appeals (R. Vol. IV, 932).

CONCLUSION

This is an ordinary patent case in which petitioner is dissatisfied with the lower court's determination of the usual issues of invention and breadth of claims. There is no conflict of decisions. The petition, therefore, does not present a question which warrants issuance of a writ of certiorari and should be denied.

Respectfully submitted,

A. DONHAM OWEN,
Attorney for Respondent.

(3)

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CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. 893.

PAYNE FURNACE AND SUPPLY COMPANY, INC., a corporation,

Petitioner,

vs.

WILLIAMS-WALLACE COMPANY, a corporation,

Respondent.

Motion for Leave to File and Petition for Rehearing.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. 893.

PAYNE FURNACE AND SUPPLY COMPANY, INC., a corporation,

Petitioner,

vs.

WILLIAMS-WALLACE COMPANY, a corporation,

Respondent.

MOTION FOR LEAVE TO FILE PETITION FOR REHEARING.

To: The Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

The above named Petitioner presents this, its Motion for leave to file the annexed Petition for a re-hearing of its Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit, and in support thereof respectfully shows: –

That re-hearing is sought because of the necessity for an authoritative and final resolution, by a decision of this Court, of the serious conflict of decisions existent respecting the interpretation and application of the disclaimer statutes, *R.S.U.S. 4917 and 4922 (35 USCA, Secs. 65 and 71)*, and *R.S.U.S. 973 (28 USCA, Sec. 821)*; and in particular with respect to the continuing

abuse of the beneficent provisions of such statutes, by patentees asserting to file disclaimers, which in fact and in law are revisions and re-statements of patent claims, without submitting the re-stated claim or claims to the constituted authorities, *i. e.*, for examination and approval by the Commissioner of Patents as required by the re-issue statute, *R.S.U.S. 4916 (35 USCA, Sec. 64)*; that this practice has resulted in a hopeless confusion of the law as demonstrated by the decisions of the District Courts of the United States and of the Courts of Appeals; that the Petition herein seeks a review of a decision of the United States Circuit Court of Appeals for the Ninth Circuit which instances by the division of said court the conflict of opinion existent respecting the applicable interpretation of said disclaimer statutes; that this case presents no issue of fact to be reviewed and the Petition for Certiorari herein presents directly, upon the adjudicated facts of the case, the questions of law sought to be reviewed, respecting which such confusion of decisions exists, and clearly illustrates the uncertainty and conflict of interpretation of said disclaimer statutes and the public need for a final determination by this Court of this conflict of decisions.

Wherefore, the Petitioner moves that leave to file the annexed Petition for Re-hearing be granted.

Respectfully submitted,

FREDERICK S. LYON,
LEONARD S. LYON,
Attorneys for Petitioner.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. 893.

PAYNE FURNACE AND SUPPLY COMPANY, INC., a corporation,

Petitioner,

vs.

WILLIAMS-WALLACE COMPANY, a corporation,

Respondent.

PETITION FOR REHEARING.

To: The Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Comes now the above named Petitioner, Payne Furnace and Supply Company, Inc., and presents this, its Petition for a Re-hearing of its Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit in the above-entitled cause, and in support thereof respectfully shows:

That its said Petition for Writ of Certiorari was filed in this Court on March 27, 1941; this Court denied said Petition on May 5, 1941.

That re-hearing is sought because of the public importance of an authoritative and final determination of the rights of patentees and of the public under the disclaimer statutes, *R.S.U.S. 4917 and 4922 (35 USCA, Secs. 65 and 71)*, and *R.S.U.S. 973 (28 USCA, Sec. 821)*.

It was early recognized that the decision of this Court in *Altoona Publix Theatres v. American Tri-Ergon Corporation*, 294 U.S. 477, did not finally determine the problems of interpretation and application of said statutes which have been and are perplexing and confusing the courts. This fact was early recognized, as exemplified in an article on the "Editor's Page" of the "JOURNAL OF THE PATENT OFFICE SOCIETY," June, 1935 (Vol. XVII., No. 6, (pp. 439-40)), wherein it was said:–

"Amendatory Disclaimers

"The recent Altoona Publix Theatres v. American Tri-Ergon Corp. decided by the Supreme Court failed to seize a glorious opportunity to cut the Gordian knot in regard to disclaimers in patent law. The Supreme Court could have boldly reformed a great abuse in patent law by abolishing amendatory or qualifying disclaimers in toto. Many years ago Mr. Justice Bradley, who was once a patent attorney, in his brilliant and heroic opinion in Miller v. Bridgeport Brass Co., 104 U.S. 350, judicially reformed the abuses of the reissue practice by establishing the well known rule of laches in regard to broadening reissues. The present disclaimer practice could have been similarly reformed in the Altoona case. The Supreme Court however in holding invalid a claim reciting means broadly for producing a result amended by a disclaimer so as to include specific means went no further than to say:

" 'If a change such as the present could validly be made, it could only be under the provisions of the reissue statute, R. S. 4916, which authorizes the alteration of the original invention in a reissued patent, upon surrender of the old patent, for its un-

expired term. Upon the reissue "the specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are." A patent amended by disclaimer thus speaks from the date of the original patent, while the reissued patent, with respect to the amended claim, speaks from the date of reissue. If respondent could thus, by disclaimer, add the flywheel to the arcuate flexing claim and to the optical claim, he would in effect secure a new patent operating retroactively in a manner not permitted by the reissue statute and without subjecting the new claims to revision or restriction by the customary Patent Office procedure required in the case of an original or reissued patent. Such transformation of a patent is plainly not within scope of the disclaimer statute, and the attempted disclaimer as applied to Claims 9 and 13 is void.'

"The Supreme Court could have easily gone one step further and definitely stated amendatory disclaimers should be prohibited pursuing the reasoning given in the above quotation.

"In this issue we publish three different views of this decision which apparently has not helped very much in clarifying the disclaimer practice.

"It is obvious from a study of the cases that the disclaimer statute has been perverted from its original intent by the practice of amending claims by disclaimers and that a cancerous legal super-structure has been permitted to grow on the simple language of the statute. The essential function of disclaimers was to cancel entire claims in order to save the rest of the patent. The practice of amending claims in any way whatsoever should never have been permitted. Under present practice amendatory disclaimers can be filed so as to practically rewrite the claims

without any examination by the Patent Office on the merits. Yet the patentee can assert *prima facie* validity of such claims and proceed against infringers."

In "STATUTORY DISCLAIMERS IN PATENT LAW," by P. J. Federico,* at pp. 41-46 it is said:–

"The second manner of disclaiming, by amending a claim of the patent, presents a number of the most difficult questions in patent law. The following sections, 10 to 21, are concerned with a discussion of these disclaimers, and other sections also relate practically entirely to questions arising therefrom.

"Disclaimers to the specification are discussed in Section 22.

"Sec. 10. Qualifying Disclaimers. There is no apt phrase with which to designate disclaimers which amend or rewrite claims of a patent. They are variously termed *partial, qualifying, amendatory, limiting,* or *speaking disclaimers.* Sometimes the term *finesse* disclaimer is used, in view of the remark that a certain disclaimer 'borders on finesse,' made in *Minerals Separation v. Butte and Superior Mining Co.,* 250 U.S. 336; 1919 C.D. 446; 264 O.G. 791. More recently they have also been called *chiseling* disclaimers, after Judge Tuttle's famous sculptural analogy in *Fruehauf Trailer Co. v. Highway Trailer Co.,* 54 F. (2d) 691; 11 U. S. Pat. Q. 258 (Mich. 1931). For want of a better term they will usually be referred to as qualifying disclaimers.

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*Mr. Federico was an Examiner of the United States Patent Office, a member of the bar of the District of Columbia and his said published work considers solely the disclaimer statutes and the decisions interpretative thereof.

"A qualifying disclaimer does not cancel a claim from a patent but it amends the claim in that it qualifies the scope of the monopoly by restricting it in certain respects. The qualification may restrict the scope of the claim to a subclass only of the broader class defined by the claim, or possibly it may exclude a specific thing from the operation of the claim. Generally these two amount to the same thing, being merely a matter of the language chosen, but occasionally there may be a real distinction between the two.

"There is no fixed style in making a qualifying disclaimer. During the course of the following sections a number of them which arose in decisions of the courts will be quoted. A review of the disclaimers as currently published in the Official Gazette will show a large variety of qualifying disclaimers, some simple, some complicated in statement and nature, and occasionally one extremely bizarre in character.

"The following eleven sections are devoted to a discussion of the validity or invalidity of qualifying disclaimers. THE DECISIONS ON THE SUBJECT ARE HOPELESSLY CONFUSED* but it is believed that they have been arranged and discussed in such a manner that the contradictions and inconsistencies are readily apparent and that the present trend is fairly indicated. Section 11 deals with the source of the authority for making such disclaimers. In Sections 13 and 14 a number of qualifying disclaimers which have been held proper by the courts are discussed. Sections 12 and 15 to 21 deal with certain phases of the subject, principally with rules and regulations which restrict the freedom to amend claims at will. CERTAIN RULES OF RESTRICTION ON QUALIFYING DISCLAIMERS ARE STATED, BUT IN CONNECTION WITH ANY GENERAL STATEMENT WHICH MAY BE PRESENTED AS A RULE

OF RESTRICTION IT MUST BE BORNE IN MIND THAT A DECISION CAN USUALLY BE FOUND WHICH IS DIRECTLY CONTRARY THERETO, OR THE FACTS OF WHICH SHOW THAT THE COURT DID NOT FOLLOW ANY SUCH RULE.*

"Sec. 11. Qualifying Disclaimers. Source of Authority. The statute does not in terms authorize the amendment of a claim by a disclaimer, as distinguished from the cancellation of a claim, and authority for so doing must be found in its general language or intent. As a matter of fact, the language of the statute is so archaic that it can be reasonably interpreted so as to have any desired meaning. The actual intent of the framers of the disclaimer statute probably cannot be determined now, and it is not known whether or not the statute was intended to apply only when several parts of an invention were separately claimed as new, so as to eliminate one of them from the patent. This meaning seems the most reasonable but if the statute did have such an intent it was soon changed in practice, since qualifying disclaimers are found among the earliest disclaimers.

"The three disclaimer sections might be readily interpreted so as to exclude the disclaiming of a part of a claim. For instance the following argument could be made. The third disclaimer section begins: 'When judgment or decree is rendered for the plaintiff or complainant . . . for the infringement of a part of a patent.' The only way this can happen is by a decree or judgment for the infringement of a claim or claims of a patent and therefore 'a part of a patent' means a claim of a patent. The next clause

*Emphasis supplied.

of the same section is: 'in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor. . . .' The only time this can happen is when a court finds a claim of the patent invalid, and consequently 'part of the thing patented,' or 'material and substantial part of the thing patented,' means a claim of the patent. The same phrases, 'part of the patent' and 'part of the thing patented,' occur in the other two sections and, giving them the same meaning, the phrase 'any such patentee . . . may . . . make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold . . .' in the first section must be equivalent to 'any such patentee . . . may . . . make disclaimer of such claims of the patent as he shall not choose to claim or hold . . . .' And in the second section the phrase, 'every such patentee . . . may maintain a suit . . . for the infringement of any part thereof (of the patent), which was *bona fide* his own,' must mean 'every such patentee . . . may maintain a suit . . . for the infringement of any claim thereof. . . .' The phrases which follow the above 'if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right,' also are fully consistent with the argument that what is meant is 'claim of the patent.' In other words, the statute only permits the disclaiming of 'part of a patent' and not part of a claim, and 'part of a patent' means 'claim of a patent.'

"In one decision, *Rumford Chemical Works v. Lauer*, Fed. Case 12,135 (N. Y. 1872), Judge Blatchford denied that the statute permitted recovery on a claim amended by disclaimer and held that the statute only applied when one claim was invalid and another claim valid, so that recovery could be had on the latter. The claim involved was, 'I claim, as a new manufacture, the above described pulverulent phosphoric acid.' It developed at the trial that the claim was anticipated. Plaintiff requested that it be allowed to recover on the claim as limited to starch mixed with the acid, since this was described in the specification as the preferred embodiment, and was new. The court stated:

" 'This view was urged, on the idea that the case falls within the ninth section of the Act of March 3, 1837, *(5 U. S. Stat. at Large,* 194,) which provides, that, when a patentee claims, in his specification, (quoting disclaimer statute). This section has no application to the case. It is designed to allow a patentee to recover on one claim of his patent, not withstanding other claims in it are void for want of novelty. But, it requires that the parts claimed without right, and the parts rightfully claimed, shall be definitely distinguishable, as matter of fact, on the face of the claims, that is, be definitely distinguished from each other in the claims. Here, there is no distinction, in the claims, between acid prepared with starch and acid prepared without starch. If there were a claim to the acid prepared with starch, and a separate claim to the acid prepared without starch,

there might, under the statute, be a recovery on the former, although the latter were void for want of novelty, provided there had been no unreasonable delay in filing a disclaimer to the latter.'

"In *Tuck v. Bramhill,* Fed. Case 14,213 (N. Y. 1868), the defendant also contended, in effect, that a claim could not be amended by disclaimer; a disclaimer could only be made when separate inventions were claimed. The claim involved was for two alternative constructions and was written in the alternative; the court, through Judge Blatchford, said that this was the same as two separate claims, one for each construction. With this view a disclaimer limiting the claim to one of the two constructions was held authorized by the statute since it was, in effect, a cancellation of a claim for the other construction.

"The above cases interpret the requirement of the statute that a disclaimer can be made if that which the patentee is entitled to claim as new is 'definitely distinguishable from the parts claimed without right,' as meaning that they must be distinguished in the patent. Since the claims are the only means provided for distinguishing what is new from what is old, they must show the difference, that is, there must be a claim for what is new as well as a claim for what is old, and this latter is to be eliminated by the disclaimer. (See Section 16 for further consideration of this phrase of the statute.)

"The broad issue as to whether or not the statute authorizes the amendment of a claim by a disclaimer

does not appear to have been raised in other decisions. In many cases the particular disclaimer involved is objected to as being improper for various reasons, but it is not usually contended that all disclaimers which amend or rewrite claims are improper. Such disclaimers have been made for so long a time and have been sustained so frequently by the courts, that it is doubtful that such an argument would be successful.

"The Supreme Court has not directly expressed itself on the broad question, although it has sustained several limiting disclaimers, for example in *Minerals Separation v. Butte and Superior Mining Co.,* 250 U.S. 336; 1919 C.D. 466; 264 O.G. 701, from which, by implication, it can be argued that limiting disclaimers are permitted by the statute. And in *Hailes v. Albany Stove Co.,* 123 U.S. 582; 1888 C. D. 177; 42 O.G. 95, occurs the dictum:

" 'Perhaps it (a disclaimer) may be used to limit a claim to a particular class of objects, or even to change the form of a claim which is too broad in its terms; . . .' The suggestion that a claim may be limited is also made in *Union Metallic Cartridge Co. v. United States Cartridge Co.,* 112 U. S. 624; 1885 C. D. 157; 30 O. G. 771.

"In *Altoona Publix Theatres v. American Tri-Ergon Corp.,* 294 U. S.....; 24 U. S. Pat. Q. 308, the Supreme Court held a particular qualifying disclaimer invalid, but it is intimated, or at least not denied, that such disclaimers may sometimes be proper. Part of the reasoning used in holding the dis-

claimer invalid is contained in the following extract from the opinion:

"'A patent amended by disclaimer thus speaks from the date of the original patent, while the re-issued patent, with respect to the amended claim, speaks from the date of re-issue. If the respondent could thus, by disclaimer, add the flywheel to the arcuate flexing claim and to the optical claim, he would in effect secure a new patent operating retroactively in a manner not permitted by the re-issue statute and without subjecting the new claims to revision or restriction by the customary patent office procedure required in the case of an original or re-issued patent. Such transformation of a patent is plainly not within the scope of the disclaimer statute, and the attempted disclaimer as applied to claims 9 and 13 is void.'

"But this reasoning is applicable to all qualifying disclaimers. The amended claim is given a retroactive action (see Section 31), and it has not been subjected to examination by the patent office. If these two facts are sufficient to render any qualifying disclaimer invalid then they would invalidate all of them."

The majority opinion of the Court of Appeals herein does not find that there is any antecedent, in either of the three claims of the patent, for the mechanical elements comprising male and female fittings providing leak-proof joints between sections of composite pipe, saying:– "It will be seen that the claims do not advert to the matter of male and female fittings so as to provide leak-proof

joints. Obviously, as witness the ordinary stovepipe, there is no novelty in a mere leak-proof flue pipe made up of sections having crimped and uncrimped ends." [R. 924; *Cf.* Petitioner's Brief on Petition for Writ of Certiorari, p. 30.] Precisely how the majority of said Court justified the disclaimers herein is not clear from the opinion. The opinion says: –

> "Part of appellant's argument is that the disclaimer here alters the original combination of a single unit pipe into one having a plurality of sections. We do not so understand the matter. The argument would require us to close our eyes entirely to the drawings and specifications of the patent. These have an explanatory or interpretative office not to be ignored. The patent discloses the inventor's conception of a composite pipe adapted—and manifestly intended—to be put together section on section to form a complete flue pipe. The drawings and specifications elucidate the claims in this respect so that no fair doubt remains concerning the nature and object of the combination invented."

A pipe may be composite, *i. e.*, formed of different materials or parts, without being made in sections to be joined together.

The apparent basis of this opinion exemplifies the confusion existent in the decisions of the district courts and courts of appeals. In the *American Tri-Ergon Corporation v. Altoona Publix Theatres, Inc.* case, in the dis-

trict court, the disclaimer therein was held valid for two reasons: "The disclaimer limits the patent and does not enlarge it." "The subject matter of the disclaimer is consistent and in accordance with the teachings of the patent." (5 Fed. Supp. 35.) This is the disclaimer which was held invalid by this Court in the *Altoona Theatres* decision. Yet we find that the Court of Appeals herein has read into the claims of the patent herein involved both the making of the composite pipe in a plurality of sections and the provision of elements or structure that form leak-proof joints. This although, as pointed out in the majority opinion, "the matter of male and female fittings so as to provide leak-proof joints" is not adverted to in the claims. The court attempts to differentiate the decision of this Court in the *Altoona Theatres* case by observing that, "The flywheel was a new part or mechanism. The limitations here are structural or functional.", and the court cites the decisions referred to in the foot-note (3) to p. 490 of this Court's decision in the *Altoona Theatres* case as supporting such interpolation into the claims of the leak-proof joints.

In Respondent's Brief in opposition to the Petition for Writ of Certiorari herein, it was asserted (p. 4) that the Court of Appeals herein "did not disregard the disclaimer. On the contrary, the Court, in construing the patent claims, expressly gave the disclaimer full effect [R. Vol. IV, 933-935]." What effect did the Court of Appeals give to such disclaimers? It specifically found, as we have pointed out heretofore, that, "It will be seen that

the claims do not advert to the matter of male and female fittings so as to provide leak-proof joints. Obviously, as witness the ordinary stovepipe, there is no novelty in a mere leak-proof flue pipe made up of sections having crimped and uncrimped ends." [R. 924.] The said majority opinion finds the novelty in the disclaimed combination of respective patent claims 1, 2 and 3. Yet the patentee has disclaimed that he is the inventor thereof except when such combination is used as a part of another combination including male and female fittings to provide leak-proof joints. As pointed out in Petitioner's original brief (p. 21), the male and female fittings forming leak-proof joints was a combination claimed in rejected application claims 3, 4, 5 and 8 [R. 936], and the majority opinion recognizes that there was no novelty therein. The case therefore presents directly the undecided question: Can a patentee disclaim that he is the inventor of a given subject-matter or combination, and thereafter be heard to assert that the sole patentable novelty disclosed in his patent is in the disclaimed subject-matter? If he can, what then becomes of the limitation of the disclaimer statutes that the part disclaimed must be a material and substantial part of the thing patented and definitely distinguishable from the parts claimed without right? (*Hailes v. Albany Stove Co.,* 123 U. S. 582.)

The confusion as to the proper interpretation of the disclaimer statute we believe is illustrated by the foregoing consideration of the majority opinion in this case.

The Questions Presented by the Case.

The precise questions presented, and which it is asked that this Court shall review, are set forth in the Petitioner's original Petition for Certiorari herein (p. 11).

As stated in the editorial in the Patent Office Journal (*ubi supra*), –

> "It is obvious from a study of the cases that the disclaimer statute has been perverted from its original intent by the practice of amending claims by disclaimers and that a cancerous legal super-structure has been permitted to grow on the simple language of the statute."

That with regard to the validity or invalidity of qualifying disclaimers, the decisions on the subject are hopelessly confused; that in the interests of justice and to prevent the perversion of the disclaimer statutes, the Writ of Certiorari herein prayed should be granted and the conflicts in these respects determined by this Court; that such conflicts are with respect to the interpretation of a Federal statute.

Wherefore, it is prayed that this Court reconsider the Petition for Writ of Certiorari to the Circuit Court of Appeals for the Ninth Circuit herein and grant the same.

FREDERICK S. LYON,
LEONARD S. LYON,
Attorneys for Petitioner.

I hereby certify that the foregoing Petition for Rehearing is filed in good faith and not for the purpose of delay.

FREDERICK S. LYON.

MAY 22 1941
CHARLES ELMORE CROPLEY
CLERK

In the Supreme Court of the United States

October Term, 1940

No. 893

PAYNE FURNACE & SUPPLY CO., INC., a corporation,

Petitioner,

vs.

WILLIAMS-WALLACE COMPANY, a corporation.

On Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit.

Respondent's Memorandum in Opposition to Motion for Leave to File and Petition for Rehearing

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Respondent's Memorandum in Opposition to Motion for Leave to File and Petition for Rehearing

We respectfully ask leave to file this memorandum in opposition to the Motion for Leave to File and Petition for Rehearing of the Order of this Court of May 5, 1941, denying the Petition for a Writ of Certiorari herein.

The Petition for Rehearing consists largely of quotations from an editorial comment on the *Altoona* case and a historical discussion on disclaimers from Federico's textbook. As indicated in the textual matter quoted, all possible questions of law relating to disclaimers have not been passed on to the full satisfaction of some text writers.

However, the questions of law raised by the facts in this case have been answered by decisions of this Court (cited in footnote 2, Brief for Respondent in Opposition, etc., p. 5).

The hypothetical questions set forth in the Petition for Certiorari (p. 11) and repeated in the Petition for Rehearing (pp. 16, 17) likewise are answered by decisions of this Court (cited in footnote 1, Brief for Respondent in Opposition, etc., pp. 3, 4).

The editorial and text quotations apparently are used by Petitioner to attack the soundness of the long established rule of qualifying disclaimers, and Petitioner is now apparently trying to obtain a rehearing on the ground that all qualifying disclaimers are invalid. However, this contention,—which is raised for the first time in this Petition for Rehearing—, is negatived by the quotation itself (Petition for Rehearing, pp. 8, 12):

> "* * * 'qualifying disclaimers are found among the earliest disclaimers.'
>
> " 'Such disclaimers have been made for so long a time and have been sustained so frequently by the courts, that it is doubtful that such an argument would be successful.' "

The metes and bounds of a proper qualifying disclaimer are well defined, and there is no confusion on this branch of disclaimer law.

The problem presented in this case is not a question of law but the application of well settled rules of law to the particular facts of this case. As to this, the Petition for Rehearing, like the Petition for Certiorari, fails to show any conflict of decisions. The question, therefore, is not one which warrants the granting of a Writ of Certiorari.

The issuance of the mandate of the Circuit Court of Appeals has been stayed because of the Petition for Rehearing. We submit that the Petition is without merit and we earnestly request, therefore, that it be ruled on at this term of court, so that no ground shall exist for delaying, until October, the proceedings for an accounting and the effective date of the injunction against further infringement herein.

Respectfully submitted,

A. DONHAM OWEN,
Attorney for Respondent.